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| 09/832,897      | 04/12/2001  | Kenichi Ueyama       | 205733US0           | 1680             |

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EXAMINER

GOLLAMUDI, SHARMILA S

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1616

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/832,897     | <b>Applicant(s)</b><br>UEYAMA ET AL. |  |
|                              | <b>Examiner</b><br>Sharmila S. Gollamudi | <b>Art Unit</b><br>1616              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt of Amendments and Remarks filed September 10, 2004 is acknowledged. Claims 1-5 and 11-29 are pending in this application.

#### ***Claim Rejections - 35 USC § 102***

The rejection of claims 1, 11, 13, 15-16, 20-21, and 23 under 35 U.S.C. 102(a) (e) as being anticipated by Reid et al (5,972,987) is withdrawn in view of the amendments filed 9/10/04.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-5 and 11-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 recites the claim language “consisting essentially of” and restricts the claim to an oil agent in the amount of 0.5-25, a solvent, and water in the amount of 0-15%.

First, it is unclear if the weight percent 0.5-25% includes both the oil agent and solvent together or the weight percent only refers to the oil agent. If the latter is the intent, the examiner suggests restructuring the claim to read “0.5-25% of at least one oil agent, solvent, and a water content of 0-15%...”

Secondly, it is unclear what the instant claim language intends to exclude. For instance, the said composition can only have a maximum weight percent of water of 15 and the maximum weight percent of an oil agent of 25. This provides for water and oil a total weight percent of

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40%, thus allowing for 60% of a solvent. However, claim 11 recites that the solvent is in the composition in a minimum weight percent of 3%. Claim 13 recites that the solvent and oil agent are in a minimum amount of 5.5%. Therefore, it is unclear what is in the remainder of the composition since the critical components of the composition, i.e. the solvent, the oil agent, and the water, do not add up to 100%. The examiner notes that instant specification on page 4, recites additional components that may be present in the composition in amounts that do not effect the compositions. However, if these additional components make-up the majority of the weight percent of the composition, then it does effect the composition rendering an entirely different compositions. It is also noted that these additional components overlap the solvents and oils agents recited in the independent claims. For instance, some surfactants and emulsifiers are oil based which would read on an "oil agent" and the polyhydric alcohols read on the "solvent".

Further clarification is requested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 11-13, 15, 20-21, 23, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunaga et al (4,495,173).**

Matsunaga et al teach a preshampoo composition, which comprises at least one decomposition derivative of keratin material. See abstract. Matsunaga discloses that preshampoo treatments are applied prior to washing the hair and then washed to prevent excessive drying during the washing process. See column 1, lines 30-40. The compositions provides for excellent

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hair conditioning effects. See column 1, lines 54-55. Example 1 teaches a formulation containing the decomposition derivative of keratin, 0.5% polyoxyethylene (15) nonyl phenyl ether, 2% lauryl alcohol (oil agent), 0.5% hydroxyethyl cellulose, 5% ethanol (solvent), and triethanolamine. Matsunaga discloses applying 2g of the preshampoo treatment and letting it remain on the hair for 5 minutes, followed by shampooing the hair.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 3, and 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself.**

Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract. The alcohols taught are glycerol, glycols, ethanol, butylene glycol, etc. see column 2, lines 50-57.

The oils taught are liquid paraffin, fatty acids, triglycerides, diglycerides, silicon compounds, and

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fatty alcohols. See column 3, lines 1-15. Komori teaches massaging the hair composition into the scalp hair. The oils liberate or dissolve the dirt on the scalp/hair. This is followed by rinsing the hair with a lot of water to wash the composition out. The composition also provides for a good for a good feeling upon use. See column 5, lines 14-30. The composition is in the form of a shampoo, preshampoo, a dandruff remover, etc. Further, the preshampoo conditions the hair so as the enable one to shampoo long and wavy hair without tangling. Examples of a preshampoo and a dandruff remover, which acts in the same manner, are disclosed. Note that preshampoos are conventionally applied to dry hair.

Komori does not specify how long the composition is kept in the hair.

It is deemed obvious to one of ordinary skill at the time the invention was made to look to the guidance of Komori et al and manipulate parameters such as concentration of individual components and the length of time the composition is left in the hair. First, one would be motivated to manipulate the concentration since Komori teaches the general parameters of the composition as taught in the abstract which falls within instant range. Therefore, it is prima facie obvious to manipulate variable such as concentration during routine experimentation to optimize the conditions of the prior art.

Additionally, it is deemed obvious to manipulate the amount of time the composition is left in the hair since this is also a variable factor that depends factors such as the length of time it takes to rub the composition into the hair and liberate the dirt, the length of time the consumer is willing to leave the composition on the hair, etc.

Lastly, it is deemed obvious to one of ordinary skill in the art to substitute one oily component with another oil component or one solvent for another. One would be motivated to do

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so since these oil agents/solvents are conventionally utilized in the hair care industry and Komori provides guidance on suitable oil agents and clearly teaches combining different types of oily agents. Absent the criticality of a particular combination, the substitution of one component known and utilized in the art for a particular purpose with another component known in the art for the same purpose, is prima facie obvious.

**Claims 1, 3, and 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936).**

Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract. The alcohols taught are glycerol, glycols, ethanol, butylene glycol, etc. see column 2, lines 50-57. The oils taught are liquid paraffin, fatty acids, triglycerides, diglycerides, silicon compounds, and fatty alcohols. See column 3, lines 1-15. Komori teaches massaging the hair composition into the scalp hair. The oils liberate or dissolve the dirt on the scalp/hair. This is followed by rinsing the hair with a lot of water to wash the composition out. The composition also provides for a good for a good feeling upon use. See column 5, lines 14-30. The composition is in the form of a shampoo, preshampoo, a dandruff remover, etc. Further, the preshampoo conditions the hair so as the enable one to shampoo long and wavy hair without tangling. Examples of a preshampoo and a dandruff remover, which acts in the same manner, are disclosed. Note that preshampoos are conventionally applied to dry hair.

Komori does not specify how long the composition is kept in the hair.

Okumura et al teach a preshampoo, hair treating composition. Okumura states that preshampoos comprising oils and fats have gained favor since it prevents damage to the hair

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during hair washing and finishing, thus imparting a conditioning effect to the washed hair to give the hair an improved look. The treating agent is applied to the hair and washed according to conventional practices. See column 1, lines 30-45. More specifically, Okumura teaches that a hair was coated with 2g of a preshampoo and letting it stand for five minutes, followed by washing. See column 4. Lastly, claim 4, Okumura makes the implicit teaching of applying a preshampoo to dry hair, explicit by stating in claim 4 that the composition is applied to dry hair.

It would have been obvious at the time the invention was made to combine the teachings of Komori et al and Okumura et al and leave the preshampoo in for the instant length of time. One would be motivated to do so since Okumura et al provides the general state of the art at the time the invention was made wherein the reference reveals that it is known to leave preshampoo in the hair for the instant length of time. Further, one would be motivated to increase or decrease this time since Matsunaga teaches preshampoos minimize and prevent damage to the hair and conditioning to the hair. Thus, the length of time would depend on factors such as the severity of damage to the hair, the amount of conditioning desired, and the consumer's willingness and desire to keep the composition in the hair. Moreover, Okumura states the conventional practice of utilizing preshampoo, known in the art to be applied to dry hair prior to washing the hair. Thus, the reference also provides the state of the art at the time the invention was made wherein it is known that preshampoos are applied to dry hair.

**Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936), in further view of Priest et al (4,296,763).**



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Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract.

Okumura et al teach the use of a preshampoo conditioner for at least 5 minutes.

The references do not specify warming the hair with a warming cap.

Priest et al disclose a hair conditioning composition contained in a heating cap. The composition contains oil and other components. See column 2, lines 3-14. Priest teaches the use of temperatures in the excess of 125 degrees Fahrenheit allow the oils such as olive oil or synthetic oils to penetrate the hair. See column 2, lines 15-17. Thus, when the hair is washed, the residual oil promotes luster, improves hair condition, and allays irritation. See column 3, lines 23-32.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the reference and use the instant temperature to treat the hair. One would be motivated to do so since Priest et al teach that a temperature in the excess of 125 degrees Fahrenheit allow oils to penetrate the hair shaft. Thus, since Komori teaches a composition for conditioning the hair prior to shampooing containing the same oils as taught by Priest et al, one of ordinary skill would reasonably expect similar results. Therefore, the motivation to utilize Komori's composition with heat is to provide for deeper conditioning benefits.

**Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936), in further view of Hulett et al (4,459,471).**

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Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract.

Okumura et al teach the use of a preshampoo conditioner for at least 5 minutes.

The references do not specify warming the hair with a warming cap.

Hulett et al teach an electrical heating cap for applying heat to the hair. The electrical thermostat maintains the desired temperature during the desired conditioning period. See abstract. The frequent use of hot rollers and electrical hair dryers tend to damage the hair, and require hair-conditioning products. These conditioners are applied to the damaged in a heat-controlled environment for a short period of time, usually about 30 minutes. See column 1, lines 5-15. The cap is held at 125 degrees Fahrenheit for a 30-minute conditioning period. See column 5, line 54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the references and utilize a heating cap in combination with the hair conditioner. One would be motivated to do so since Hulett et al teach the state of the art for conditioning damaged hair. Hulett states that applying a conditioner to the hair and heating it with a cap for thirty minutes is known in the art for damaged hair. Therefore, one would be motivated to add heat to provide for a more intensive conditioning process if the hair is severely damaged.

### ***Response to Arguments***

Applicant's arguments filed 9/10/04 have been fully considered but they are not persuasive.

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Applicant argues that while Komori et al teach overlapping ranges, Komori does not exemplify all the instant embodiments. For instance, applicant argues that Komori teaches an oil agent in the amount of 20-98% but teaches a preferred concentration of 50-98%. Applicant argues there is not motivation to apply the composition as a pre-shampoo wherein the composition is applied to dry hair, followed by washing.

Firstly, the examiner points out that the instant rejection is made under obviousness and not under anticipation. Therefore, the instant invention need not be exemplified, it merely has to be suggested. The instant invention requires an oil agent in the amount of 0.5-25%, a solvent, and 0-15% water. Komori teaches a composition containing 0.05-15% of a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of an oil. Therefore, it is quite clear that the instant ranges are taught and that a skilled artisan would be motivated to manipulate the concentrations within the ranges provided by the prior art. This is deemed *prima facie* obvious.

With regard to Komori's preferred embodiments of 50-98% oil, the examiner points out that disclosed examples and preferred embodiments do not constitute a teaching away from the broader disclosure or nonpreferred embodiments. See *In re Susi*, 169 USPQ 423 (CCPA 1971). Thus, since Komori teaches 20-98% which falls within the claimed range, it is the examiner's position that Komori *suggests* the instant invention.

With regard to Komori's lack of teaching of the instant application and a preshampoo, the examiner points to column 2, lines 8-12 wherein Komori clearly states that the composition may be a shampoo in the classical sense but also a preshampoo, a hair-make remover, a dandruff remover, and hair conditioner. More specifically, example 11 teaches a preshampoo composition. The examiner points out that the terminology preshampoo, as also acknowledged by the

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applicant, denotes the instant method of applying the composition and then washing it away. Further, the examiner points to US 4,279,269 to Horin et al wherein clearly Horin teaches the definition of a “preshampoo”.

Applicant argues that although the secondary references, Okumura et al and Horin et al, teach a preshampoo composition, the references do not teach the instant composition.

The examiner points out that once again, that the claims are made under obviousness and thus a secondary reference is relied upon to teach a *specific* teaching and it does not have to teach the entire invention, otherwise it would be said to anticipate the invention. In instant case, the examiner relies on Okumura to teach the preshampoo art and not the composition itself, which is not by Komori et al. Okumura teaches that it is conventional to apply a preshampoo to dry hair for instant length of time and then wash it out.

Therefore, the rejection is maintained for the reasons above.

**Claims 1-5, 11-15, 19, 23, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanba et al (5,286,476) in view of Andersin (GB 824,353), in further view of Priest et al (4,296,763).**

Nanba discloses that hair washing, brushing, blow-drying, etc, damage the hair causing split ends and dry hair. Nanba et al teach the composition provides smooth hair feel, prevents split ends, and repairs the hair. Moreover Nanba states that conventionally oil components are added to hair compositions to protect and repair the hair. See column 1, lines 14-10. Nanba et al teach a hair oil composition containing 20% octamethylcyclotetrasiloxane, 0.5% dimethylpolysiloxane, and 79.5% trichlorotrifluoroethane. See example 6.

Nanba et al does not teach the method in utilizing the hair oil, i.e. leaving it in for a prolonged period of time, followed by washing it out.

Andersin teaches a hair oil containing oil and an alcohol for hair improvement. Andersin teaches that hair oil is rubbed into the scalp and wrapped in a scarf to allow the oil to penetrate the scalp without disturbance as long as possible. After this, the hair must be washed and rinsed to provide hair that has new life and is elastic. See column 1.

Priest et al disclose a hair conditioning composition contained in a heating cap. The composition contains oil and other components. See column 2, lines 3-14. Priest teaches the use of temperatures in the excess of 125 degrees Fahrenheit allow the oils such as vegetable or synthetic oils to penetrate the hair. Further, the oils act effectively to condition the hair if the oil is left on the hair for 15 to 20 minutes at elevated temperatures. See column 2, lines 15-17. Thus, when the hair is washed, the residual oil promotes luster, improves hair condition, and allays irritation. See column 3, lines 23-32.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nanba et al, Andersin, and Priest et al and utilize Nanba's hair oil in the instant manner. One would have been motivated to do so since Andersin teaches the general state of hair oil treatment art wherein for conditioning purposes, oil is left on the hair as long as possible to allow the oil to penetrate the scalp and then shampooed; thus improving hair texture. Moreover, Priest et al states that if heat is applied to the hair containing an oil composition, the oil penetrates the hair shaft better and conditions the hair effectively in 15 to 20 minutes. Thus, a skilled artisan would expect better conditioning effects by leaving the oil in the

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hair for instant amount of time since this allows the oil to penetrate the scalp and heat allows for faster penetration of the oil.

*Art of Interest*

US patent 4,279,269 to Horin et al is cited to provide a general state of the art wherein a pre-shampoo treatment hair application provides for a composition that is applied to dry hair followed by shampooing.

*Conclusion*

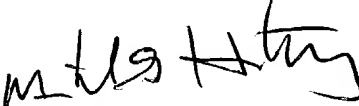
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi  
Examiner  
Art Unit 1616

SSG

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER